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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PETITION TO THE COMMISSIONER FOR WITHDRAWAL OF ABANDONMENT

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MAR 16 1993  
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Inventor: Thomas L. Savoy  
Serial No.: 07/458,168  
Filing Date: December 28, 1989  
Date: March 4, 1993  
Examiner:  
GROUP 150  
Group Art Unit: 154

For: BUILDING MATERIAL WITH PROTECTION FROM INSECTS, MOLDS AND FUNGI

\* \* \* \* \*

Hon. Commissioner of Patents  
and Trademarks  
Washington, D. C. 20231

Dear Sir:

Applicant petitions the Commissioner to review the above case on the basis of Patent and Trademark Office error in sending a Notice of Abandonment. No fee is submitted herewith, as the cause for apparent abandonment rests within the Office.

The following facts are relevant and are verified by a Declaration in accordance with 37 C.F.R. 1.68.

1. U.S. Patent Application Serial No. 07/458,168 was filed December 28, 1989.
2. Applicant received an Office Action mailed January 18, 1992 on January 22, 1992, copy attached as Exhibit 1.
3. Applicant responded to the Office Action on January 25, 1991. The Response was received in the Patent and Trademark Office mail room on January 30, 1992. Copies of the Response and date stamped postcard are attached as Exhibit 2.
4. Applicant received on August 29, 1991, a Notice of Abandonment, mailed August 26, 1991, Exhibit 3.

5. Applicant's counsel promptly telephoned Examiner Van Balen and said that we had replied well within the time limits. Examiner Van Balen suggested that we request reconsideration of the holding of abandonment because of the apparent Patent and Trademark Office error.
6. On September 4, 1991, applicant submitted a Request for Reconsideration of holding of Abandonment pursuant to M.P.E.P. § 711.03. This was received in the Patent and Trademark Office mail room on September 9, 1991. Copies of the Request and the return postcard are attached as Exhibit 4.
7. In April or May 1992, coounsel left telephone messages for Examiner Van Balen to review the matter and call us back. No response.
8. On July 21, 1992, applicant filed a Request for Status, copy attached with return postcard as Exhibit 5.
9. A response was received on August 26, 1992, that the file did not have a Request for Reconsideration in it and that application was abandoned.
10. Group Art Director Thomas was contacted on March 3, 1993, and suggested we file a petition to review. We were told by the telephone receptionist that Examiner Van Balen was no longer employed by the Patent and Trademark Office.

Accordingly, it appears that the Patent and Trademark Office has lost both the Response to the Office Action filed on January 30, 1991 and the Request for Reconsideration filed on September 9, 1991.

Properly, this Petition is for a holding that the case was never abandoned, but that a mistake was made in the Patent and Trademark Office procedures. Applicant never abandoned the application, either intentionally or unintentionally.

There are two continuation/divisional applications proceeding from U.S. Patent Application Serial No. 07/458,168; namely, Application Nos. 07/647,995 and 07/756,354.

Applicant has also not filed a disclaimer pursuant to 37 C.F.R. 1.137(c) because it simply wants the Patent and Trademark Office to correct its error.

No fee is also filed because of the Patent and Trademark Office error. This is in accordance with the advice of Group Director Thomas.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Thomas L. Savoy

Serial No. 07/458,168

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

THOMAS L. SAVOY

By WIRKEN & KING

By Wm. Bruce Day  
Wm. Bruce Day  
Reg. No. 29,059  
Attorney

WBD/dh  
ENCLOSURES  
4740 Grand Avenue  
Third Floor  
Kansas City, Missouri 64112  
Telephone: 816-753-6666

I hereby certify that this correspondence is being deposited with  
the United States Postal Service as first class mail in an  
envelope addressed to Commissioner of Patents and Trademarks,  
Washington, D.C. 20540 on March 4, 1993

Wm. Bruce Day  
Wm. Bruce Day  
P. O. Reg. 29,059  
Date March 4, 1993



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO.

07/458,168 12/28/89 SAVOY

T

JUN 22 1991

EXAMINER

WIRKEN & KING  
4740 GRAND AVENUE, THIRD FLOOR  
KANSAS CITY, K MI 64112

ART UNIT PAPER NUMBER

154

DATE MAILED:

01/18/91

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 30 month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ \_\_\_\_\_

Part II SUMMARY OF ACTION

1. ☒ Claims 1-41 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☐ Claims \_\_\_\_\_ are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☒ Claims 1-41 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-20, drawn to a building panel, classified in Class 428, subclass 304.4.

II. Claims 21-31, drawn to a process for making a building panel, classified in Class 156, subclass 78.

III. Claims 32-41, drawn to a building material and a process for making a building material, classified in Class 521, subclass 55.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and of Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the panel of Group I could be made by a materially different process such as extruding hot expanding or expanded polystyrene between and in contact with two skins or by more than a single disclosed process as applicant admits such as set out on pages 3-6 in the specification.

Inventions of Group I <sup>or</sup> of Group II, and of Group III are related as combination and subcombination. Inventions in this

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relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because no adhesive present. The subcombination has separate utility such as a paper weight.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and since the fields of search are not coextensive, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Any inquiry concerning this communication should be directed to William J. Van Balen at telephone number (703) 308-2351.

**WILLIAM J. VAN BALEN**  
DEPUTY EXAMINER  
Art Unit 154

Applicant: Thomas L. Souoy Date: January 25, 1991  
Serial No.: 07/458,168 Group Art/Law Office: 154  
Filing Date: December 28, 1989 Examiner: W. Van Buren  
For: Building Material With From  
Insects, Molds and Fungi  
Instrument: Amendment



The Official date stamp of the United States Patent and Trademark Office hereon is evidence of the fact that subject instrument for the above-identified case has been received by the U.S. Patent and Trademark Office.

0 647995

FEB 08 1991





UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/158,153	12/02/88	SAVOY	T

WIRKEN & KING  
4740 GRAND AVENUE, THIRD FLOOR  
KANSAS CITY, K MI 64112

EXAMINER	
VAN BALEN, W	
ART UNIT	PAPER NUMBER
154	6

DATE MAILED:

08/26/91

AUG 29 1991

NOTICE OF ABANDONMENT

This application is abandoned in view of:

- ☒ Applicant's failure to respond to the Office letter, mailed 1-18-91.
- ☐ Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
- ☐ Applicant's failure to timely file the response received \_\_\_\_\_ within the period set in the Office letter.
- ☐ Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of \_\_\_\_\_ of the Notice of Allowance.

☐ The issue fee was received on \_\_\_\_\_.

☐ The issue fee has not been received in Allowed Files Branch as of \_\_\_\_\_.

In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17 (l), and a verified showing as to the causes of the delay.

If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of *Delgar Inc. v. Schuyler*, 172 U.S.P.Q. 513.

- ☐ Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by \_\_\_\_\_ as required in the last Office action.

☐ The corrected and/or substitute drawings were received on \_\_\_\_\_.

- ☐ The reason(s) below.

*William J. Van Balen*  
WILLIAM J. VAN BALEN  
PRIMARY EXAMINER  
ART UNIT 154



RESPONSE TO STATUS INQUIRY

CURRENT STATUS (Appropriate Box Checked)

RE: Application NO. 07-458,168

☐ Transferred to Group Art Unit

☐ Awaiting applicant's response to Official Action mailed

☒ Abandoned on January 18, 1991

☐ New Case, awaiting first action by Examiner

☐ Amended case, awaiting action by Examiner

EXPECTED DATE for action on this application \_\_\_\_\_, 19\_\_

There is no record of the communication Applicant  
status he sent September 4, 1991 in the Application

Patent Examining Group 150

Kerry SAE Group 150  
8/18/92